

REMARKS

I. Status of the Claims

Claims 18, 20-28, and 30-51 are pending in this application.

II. Rejections Under 35 U.S.C § 103

In the Office Action dated January 16, 2007, the Examiner rejected Claims 18, 20-28, and 30-51 under 35 U.S.C. § 103(a). The Examiner added an additional reference, Oshima (JP401009916A), to the previously-cited 103(a) references Mitsumatsu (WO 99/13830) and Sebag (WO 98/03155). The Examiner notes that Oshima teaches "a shampoo containing . . . surfactant and stearyl alcohol and behenyl alcohol as essential components, wherein the amounts of stearyl (C18) alcohol and behenyl (C22) alcohol are 0.5-5 [sic] wt % and 0.75-7.5 wt %, respectively, and the weight ratio of the alcohols is 1:1.15-4.5." See Office Action at p. 3. The Examiner asserts that this teaching remedies the deficiency that Mitsumatsu does not provide a specific example which concurrently uses stearyl alcohol and behenyl alcohol in the amounts and the ratio required by Applicants' claims. See independent claims 18, 47, 49, and 50. For the reasons discussed below, Applicants respectfully disagree and submit that there is no suggestion or motivation to combine the references.

Several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims of a patent application under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and

(4) Evaluate evidence of secondary considerations.

The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 USPQ 467; *see also KSR Int'l Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007), slip op. at 2.

Thus, in order to satisfy the initial burden of establishing a *prima facie* case of obviousness, the Examiner must show that there is some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references. *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). The Supreme Court, in the recent *KSR* case, recognized that a showing of "teaching, suggestion, or motivation" could provide helpful insight in determining whether the claimed subject matter is obvious under Section 103(a). *KSR*, slip op. at 14.

In addition, the Supreme Court mandates that "[t]o facilitate review, this analysis [of whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue] should be made explicit." *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Federal Circuit, 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness")).

Following the *KSR* decision, the Office issued a memorandum to its technology center directors on May 3, 2007, indicating that "**in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would**

have combined the prior art elements in the manner claimed." (Emphasis in original).

In the current Office Action, the Examiner puts forth two reasons why it would have been obvious to one of ordinary skill in the art to modify Mitsumatsu by using stearyl and behenyl alcohols in the weight ratio as motivated by Oshima. Applicants respectfully submit that the Examiner's reasons are flawed for the reasons set forth below.

The first reason given by the Examiner is because "Mitsumatsu suggests using stearyl and behenyl alcohols within the weight amount which overlaps with Oshima." See Office Action at p. 3. Applicants respectfully disagree with the Examiner as to the factual accuracy of this point. In Examples 3, 4 and 5 of Mitsumatsu, the only instances of weight amounts given in the reference, stearyl alcohol and behenyl alcohol are not present together in the same composition, and individually have weight amounts of 0.1 wt % for behenyl alcohol in Example 3 and 0.1 wt % and 0.2 wt % for stearyl alcohol in Examples 4 and 5 respectively. As previously noted, Oshima gives weight percentage ranges for stearyl and behenyl alcohol of 0.5-5 [sic] wt % and 0.75-7.5 wt % respectively, which does not overlap with the weight percentages given by Mitsumatsu for behenyl alcohol in Example 3 or for stearyl alcohol in Examples 4 and 5.

The second reason the Examiner gives for combining Mitsumatsu and Oshima is that "Oshima teaches the combination of the two fatty alcohols in a specific ratio in a shampoo formulation which is stable and imparts excellent hair conditioning effect." See Office Action at p. 3. As can be seen from the English translation of the Oshima reference which Applicants have provided, while Oshima does teach the combination of

the two fatty alcohols, it also contains an anionic surfactant and/or an ampholytic surfactant of specific formulas and a polypeptide with a specific molecular weight and weight percent as "essential" components necessary to achieving pearl luster and storage stability. See Oshima English translation p. 2-6. The reference only describes that the composition itself has excellent storage stability and hair-conditioning effect, not that the combination of stearyl and behenyl alcohol are responsible for these properties. Thus, the Examiner has not provided an adequate reason to combine the references and consequently has not established the requisite *prima facie* case of obviousness.

In addition, with respect to the opacifier/pearlescent component, while the Examiner acknowledges that Mitsumatsu and Oshima "fail[] to teach the opacifier/pearlescent recited in claims 19-25," the Examiner continues to rely upon the Sebag reference to remedy this deficiency. However, one skilled in the art would not have been motivated to modify Mitsumatsu in view of Sebag.

Mitsumatsu does teach shampoo formulations comprising triazole as an essential ingredient, with additional *optical brighteners* available "which have the same characteristics as the triazoles with respect to ultraviolet light absorption and visible light emission." Mitsumatsu, p. 39, lines 1-2. However, Mitsumatsu does not include opacifiers or pearlescent agents among the lengthy list of other additional components. *Id.* at p. 41, lines 9 - 28. As set forth in the arguments of record, one of ordinary skill in the art would recognize that optical brighteners, as disclosed in Mitsumatsu, functionally differ from the presently claimed opacifiers/pearlescent agents. Applicants reiterate that it is in view of these fundamental differences that one of ordinary skill in the art would

not have been motivated to substitute an opacifier for Mitsumatsu's optical brightener and the Examiner has not provided an adequate reason for doing so.

Sebag does not remedy this deficiency. One of ordinary skill would not have been motivated to substitute an opacifier or pearlescent agent, such as dialkyl ether, for Mitsumatsu's optical brightener at least because Sebag does not suggest that dialkyl ether is even responsible for the pearlescent effect. Applicants submit that without any adequate reason to do so, one of ordinary skill in the art would not have modified Mitsumatsu in view of Sebag.

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 16, 2007

By: 

Mark D. Sweet
Reg. No. 41,469